

REMARKS

The Office Action of November 20, 2002 has been reviewed and carefully considered.

Originally-submitted claims 1 to 13 have been cancelled and replaced by new claims 14 to 53, of which claims 14 and 37 are independent claims and the remainder depend variously therefrom. Thus, claims 14 to 53 are now pending in the application.

Reconsideration of the above-identified application, as herein amended, is respectfully requested.

In the Office Action of November 20, 2002, all of the originally-submitted claims 1 to 13 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. In addition, claims 1, 2 and 11 and their dependent claims were rejected under 35 U.S.C. §101 as nonstatutory for positively reciting a portion of the human body. Finally, each of claims 1 to 13 was rejected under either 35 U.S.C. §102 as anticipated by U.S. Patent No. 271,121 to Riley et al. or under 35 U.S.C. §103(a) as rendered obvious by the Riley et al. patent.

In response to those rejections, applicant has cancelled originally-submitted claims 1 to 13 and replaced them with new claims 14 to 53. Claims 14 to 53 are believed to recite the invention in a notably clarified manner that clearly differentiates and distinguishes over all of the prior art of record. In addition, new claims 14 to 53 have been drawn to avoid the Section 112, second paragraph and Section 101 bases for rejection raised by the Examiner in the first Office Action.

The present invention is directed to an earring having a specially-configured attachment portion. The inventive earring includes, as is not uncommon in the earring art, a decorative part -- such for example as the decorative ring shown in the drawings and described by way of illustrative

example in the specification -- that is suspendable from the earlobe of the user and which defines a plane of suspension of the decorative part along which the decorative part is adapted to be suspended from the user's earlobe. The attachment portion of the invention, which is formed by a continuous unitary member, is configured so that, when the earring is worn by a user, the decorative part suspension plane lies and is maintained substantially parallel to the sagittal plane of the user. In other words, by virtue of the recited construction of the inventive earring, and more particularly of the attachment portion thereof, the suspendable decorative part of the earring is disposed and maintained in the vertical plane which, as should be evident, notably enhances the appearance, to third parties, of the inventive earring when worn by a user.

None of the prior art cited by the Examiner in the First Office Action, or otherwise known to applicant, teaches or discloses or suggests the unique attachment portion recited in each of the newly-proffered independent claims 14 and 37. The claimed attachment portion, which depends from the decorative part for captive insertion through a hole in the user's earlobe, includes at least first and second elongated substantially rectilinear portions that meet to form an angular return bend between the two portions. The first rectilinear portion extends at a first angle relative to the suspension plane of the decorative part, the first angle conforming to a first angle of separation that is defined by a user's earlobe (to which the earring is attachable) with respect to the sagittal plane of the user. The angular return bend between the first and second rectilinear portions defines a second angle such that, when the attachment portion unitary member is inserted through the earlobe hole to suspend the decorative part from the user earlobe, the first rectilinear portion extends captively through the earlobe hole such that the decorative part suspension plane lies substantially parallel to the user's sagittal plane and the second rectilinear portion extends externally of the earlobe to maintain the earring in selectively disengageable captive engagement to the user earlobe.

None of the prior art teaches this advantageous construction of an earring. Neither does any of the prior art teach, or even recognize or suggest, that maintenance of a substantially parallel relationship between the decorative part suspension plane of an earring and the sagittal plane of a user on whom the earring may be worn can be assured by an earring attachment portion structure such as that recited in applicant's newly-submitted claims in which the so-called "angle of separation" defined by a user's earlobe with respect to the sagittal plane of the user can provide a guide in configuring the attachment part to realize the intended advantageous result.

It should be noted, however, that no portions of the human body are positively recited in newly-submitted claims 14 to 53 as an element of a claim. Those portions of a human body which are mentioned in the claims simply refer to physical aspects of a user to whom the inventive earring is disengageably attachable. Such references are perfectly permissible in claiming an apparatus intended for use by such a user.

Since originally-submitted claims 1 to 13 -- against which the cited Riley et al. patent was applied -- have been replaced in their entireties by new claims 14 to 53, it is believed that no express discussion of the teachings of the Riley et al. patent is necessary at this time. Suffice it to say that neither the Riley et al. patent, nor any of the other prior art cited as of interest in the first Office Action, in any way teaches or suggests the novel earring construction now recited in independent claims 14 and 37 or in their various dependent claims, and that claims 14 through 53 are accordingly deemed patentably distinct over that cited art.

Applicant also wishes to comment regarding the Examiner's citation of *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) in the Section 103 rejection set forth in the first Office Action. That case was cited by the Examiner for the proposition that "discovering an optimum value of a result effective variable involves only routine skill in the art" and, the Examiner therefore

concluded, "it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have the angle claimed" by applicant herein. With due respect, applicant vigorously disagrees with the Examiner's citation and ensuing analysis.

In re Boesch merely states that the optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Boesch*, 205 USPQ at 219. In *Boesch*, the claims at issue recited a combination of elements, required in specified amounts, to form a composition. As the court however found, the prior art in that case itself "suggested the kind of experimentation necessary to achieve the claimed composition, including the proportional balancing described by appellants' Nv equation." Thus, the prior art already disclosed the same composition, and suggested that the amounts of the individual elements that form the composition be varied to achieve the same result claimed by the appellant in *Boesch* whose claims were there at issue.

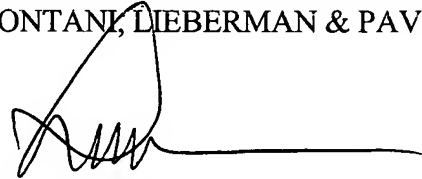
In the present application, on the other hand, *nothing* in the prior art teaches or suggests consulting of the so-called "angle of separation" that a user's earlobe defines with respect to the sagittal plane of the user to identify an advantageous angle (the "first angle" in the claims) that can be employed, in applicant's recited earring attachment portion construction, to assure that the decorative part of the earring will be properly suspended and maintained substantially parallel to the user's sagittal plane when the earring is worn by such user. The *In re Boesch* case is inapposite to the present invention and to the claims at hand here.

In view of the foregoing and the enclosed, applicant submits and sincerely believes that newly-proffered claims 14 to 53 patentably distinguish over the prior art and are in condition for expedited allowance. Such action, and early passage of case to issue, are once more requested.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By

A handwritten signature in black ink, appearing to be "Lance J. Lieberman", written over a horizontal line.

Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: May 19, 2003